REMARKS/ARGUMENTS

The Office Action of January 27, 2005 has been carefully reviewed and this response addresses Examiner's concerns stated in the Office Action and puts the remaining claims in condition for allowance. The telephonic interview summary mailed February 16, 2005 has also been carefully reviewed and completely and properly made of record according to MPEP § 713.04 as follows.

On February 9, 2005, a telephonic interview among Examiner and Applicants' attorneys, Jacob Erlich and Kathleen Chapman, was conducted. The claims that include the term "secure memory", i.e. claims 1, 10, 12, 14, and 19, were discussed with respect to the prior art of record, i.e. Petrovich. Examiner states that Applicants' representatives contacted Examiner to discuss the definition of "secure memory" and "secured memory". Examiner states that Applicants' representatives' position was that "secure memory" and "secured memory" are terms of art, and cited passages in the specification defining the phrases. Examiner argued that "secure memory" and "secured memory" are not terms of art, and can be considered more broadly than Applicants' definition to include the configuration shown in Petrovich. Examiner states that agreement was not reached at the time in regards to the definition of these phrases.

Applicants appreciate Examiner's taking the time to discuss the differences between secure memory and access control, and respectfully present a declaration from a person of ordinary skill in the art, James D. Issak, to substantiate Applicants' position. During the interview, Examiner agreed to review such a declaration. Further, with respect to Examiner's summary, Applicants do **not** maintain that "secured memory" is a term of art, but continue to maintain that "secure memory", an element of Applicants' claims 1, 10, 12, 14, and 19, is a term of art. Although amendments were not discussed, and although Applicants believe that claims 1 and 10 are correctly claimed, Applicants have amended claims 1 and 10 to reduce any potential

confusion. Applicants respectfully continue to assert that a product or resource called "secure memory" is readily available, has a specific meaning to those skilled in the art, and is not considered to be access control as is commonly known in the art and as is disclosed in Petrovich.

Claims 1-19 and 21-29 are currently pending in the application. Claims 1, 10, 17, 23, and 24 have been amended under 37 C.F.R. § 1.116 in order to put those claims, and any claims that depend therefrom, in condition for allowance. Claim 20 has been cancelled without prejudice. Claims 26, 27, and 29 have been withdrawn in response to Examiner's constructive election, in view of which Applicants retain the right to present claims 26, 27, and 29 in a divisional application.

On page 2, paragraphs 1-2 of the Office Action, Examiner states that claims 26, 27, and 29 are directed to an invention that is independent or distinct from the invention originally claimed. Examiner states that claim 26 is directed to a system to securely manage at least one financial transaction, that claim 27 is directed to a method of creating and using secure memory, and that claim 29 is directed to a system for creating and using secure memory. Examiner states that claims 26, 27, and 29 are each distinct from the purchasing aid logistics appliance, and the method of using the appliance, that were presented in the originally filed claims. Examiner states that since Applicants have received an action on the merits for the originally-presented invention, this invention has been constructively elected by original presentation for prosecution on the merits.

On pages 2-3, paragraphs 3-5 of the Office Action, claims 22 and 23 are rejected under 35 U.S.C. §102(b) as being anticipated by Petrovich et al., United States Pat. No. 6,101,483, issued August 8, 2000 (Petrovich).

With respect to independent claim 22, Examiner states (paragraph 4) that Petrovich discloses a method for using a portable appliance (40) that includes

(1) downloaded product data from a bar coded advertisement (col. 4, lines 56-58).

As a rebuttal to Examiner's position, Applicants respectfully point out that Petrovich discloses a portable terminal that includes a two-way data interface which is configured to read bar codes associated with items related to shopping (col. 4, lines 56-58). Nowhere does Petrovich disclose downloading product data from a bar-coded advertisement. Reading of a bar code (Petrovich) and downloading product data from a bar-coded advertisement (Applicants) are two different actions. A typical cash register reader reads a bar code into a cash register. This is analogous to the system of Petrovich. Applicants, on the contrary, claim downloading product data from a bar-coded advertisement. In the system of Applicants, a bar-coded advertisement is scanned and product data is downloaded as a result. Nowhere does Petrovich disclose such a sequence of events.

> (2) creating a shopping list from said product data and transmitting the shopping list to a merchant computer upon entry into a merchant facility (col. 2, lines 18-34).

As a rebuttal to Examiner's position, Applicants respectfully point out that Petrovich discloses a portable terminal to read bar codes, a memory to store data associated with the bar codes, a kiosk cradle to accept the data and to download the data to a host computer. The sequence of operations that Petrovich, in col. 2, lines 18-34, discloses is that bar codes are read and stored, and then later downloaded to a host computer. Applicants claim, on the contrary, downloading product data from a bar-coded advertisement, creating a shopping list from the product data, and transmitting the shopping list to a merchant computer upon entry into a merchant facility. Petrovich does not disclose creating a shopping list from product data that is downloaded from a bar-coded advertisement and then transmitting the shopping list to a merchant computer.

> (3) receiving updated product data from said merchant computer upon entry into the merchant facility (col. 10, lines 25-29, user receives the location of products on the list).

As a rebuttal to Examiner's position, Applicants respectfully point out that Petrovich discloses that a shopping list can be produced from data from the merchant computer (the host computer 16 of Petrovich) about the location of items within the merchant's shopping establishment. Applicants, on the contrary, claim receiving updated product data (downloaded from a bar-coded advertisement) from the merchant computer upon entry into the merchant facility. Thus, while Petrovich uses a bar code reader to scan items to create a shopping list which presumably consists of bar codes, not product data (because it is not clear from Petrovich how the bar code reader could have stored references to any possible product data that could be associated with any possible bar code), Applicants claim downloading product data from an advertisement. These steps are not equivalent. And while Petrovich provides the shopping list (of bar codes) to the merchant computer and receives locations of the items on the shopping list in return, Applicants claim that the merchant computer updates the product data upon entry into the merchant facility, where the product data had originally been downloaded from an advertisement. Again, these steps are not equivalent because updating product data that had previously been downloaded is different from sending a list of bar codes to the merchant computer and receiving locations of items in return.

Applicants assert that since Petrovich does not set forth each and every element of Applicants' independent claim 22, either expressly or inherently, Applicants' independent claim 22 (and claim 23 which depends from claim 22) is not anticipated by Petrovich and a rejection under 35 U.S.C. §102(b) is inappropriate. Therefore, Applicants respectfully request the withdrawal of the rejection under 35 U.S.C. §102(b) with regards to independent claim 22 (and claim 23 which depends from claim 22) for the reasons set forth above. Furthermore, a 35 U.S.C. § 103 rejection of these claims would be inappropriate as well. Applicants' claimed invention is not an obvious extension of the use of Petrovich to meet Applicants' patentable limitations.

Additionally, Applicants have amended dependent claim 23 to further define the invention:

Claim 23: (previously presented) The method as defined in claim 22 further comprising the step of:

identifying the product data with a master control code, the master control code associating a merchant with the product data, the master control code being read from the bar coded advertisement.

Applicants respectfully request Examiner to reconsider the rejection of claim 23 in light of Applicants' arguments for claim 22 or, alternatively, the amendments for claim 23 which are underlined. To further Applicants' position of the patentability of amended dependent claim 23, Applicants note the following.

With respect to dependent claim 23, that depends from independent claims 22, which is now in condition for allowance, Examiner states (paragraph 5) that Petrovich discloses (col. 11, lines 33-40) identifying product data with a master control code, where the master control code associates a merchant with the product data. Examiner notes that different products are associated with different merchants. Examiner states that this is done by the appliance. Examiner considers the code responsible for this function to be the master control code.

Applicants respectfully point out that Petrovich discloses that the storing step, which includes storing data in memory that is associated with bar codes that were read from a 2-way data interface of a portable terminal, includes storing data pertaining to a shopping establishment each time the data are stored in memory. Applicants, on the contrary, claim a master control code that is read from the bar coded advertisement, and that associates a merchant with the product data.

Applicants assert that since Petrovich does not set forth each and every element of Applicants' dependent claim 23, either expressly or inherently, Applicants' dependent claim 23 is not anticipated by Petrovich and a rejection under 35 U.S.C. §102(b) is inappropriate. Therefore, Applicants respectfully request the withdrawal of the rejection under 35 U.S.C. §102(b) with regards to dependent claim 23 for the reasons set forth above. Furthermore, a 35 U.S.C. § 103 rejection of these claims would be inappropriate as well. Applicants' claimed invention is not an obvious extension of the use of Petrovich to meet Applicants' patentable limitations.

On pages 3-10, paragraphs 6-24 of the Office Action, claims 1-5, 8, 9, 11, 13, 15, 16, 18, 24, and 25 are rejected under 35 U.S.C. §103(a) as being unpatentable over Petrovich in view of Treyz et al., United States Pat. No. 6,587,835 (Treyz), issued July 1, 2003.

Applicants further respectfully point out that Examiner's cited reference, Treyz, was issued on July 1, 2003, over a year after the filing date of the present application, January 4, 2002. Applicants respectfully reserve the right to file a petition under 37 C.F.R. § 1.131 to swear behind Treyz.

Applicants have amended independent claim 1 under 37 C.F.R. § 1.116 to put claim 1 in condition for allowance:

Claim 1: (previously presented) A portable 2-way secure purchasing aid logistics appliance, comprising:

means for inputting information;

a central processor coupled to said means for inputting information to generate a shopping list, wherein said central processor includes application software to maintain a budget and to perform finance computations and to track financial accounts;

~~means for providing~~ a secure memory coupled to said central processor to safeguard

personal and financial information;

means for outputting said shopping list, and said personal and said financial information;

and

a display to view said shopping list.

Applicants respectfully request Examiner to reconsider the rejection in light of

Applicants' amendments which are struck through. To further Applicants' position of the

patentability of amended independent claim 1 (and dependent claims 2-17 and 25 that depend,

directly or indirectly, from amended claim 1), Applicants note the following.

With respect to independent claim 1, on page 4, in paragraphs 8 and 9 (and in paragraphs

42-43, page 16):

(1) Examiner states (paragraph 8) that Petrovich discloses a central processor coupled to

said means for inputting information to generate a shopping list (col. 5, line 37).

As a rebuttal to Examiner's position, Applicants respectfully point out that Petrovich

discloses that the host computer 16 receives the data associated with the bar codes of the

shopping-related items and stores the data in a shopping list database. The host computer 16 of

Petrovich is equivalent to the merchant computer 66 of Applicants in that it communicates with

the portable terminal 40 of Petrovich (see Petrovich FIG.1). Applicants claim a central processor

11 (see Applicants' FIG. 1) that is part of the purchasing aid logistics appliance 10 which

communicates with merchant computer 66 (see Applicants' FIG. 7). Thus, the central processor

11 of Applicants is not disclosed by Petrovich.

(2) Examiner states (paragraph 8) that Petrovich discloses means for securing memory

coupled to said central processor to safeguard personal and financial information (col. 5, lines 19-

22 and 55-61). Examiner also states (paragraph 43) that anything that has restricted access is considered to be secure, and that access control is one type of security. Examiner states that the definition of "secure" provided by Applicants appears to allude to encryption, but that "secure" and "encrypted" are different. Examiner states that "secure" encompasses a broader range of methods of restricting access to memory, and that, as such, "access control" of Petrovich is considered to provide "secure memory".

As a result of the phone interview with Examiner on February 9, 2005, Applicants have provided a declaration by a person of ordinary skill in the art, James D, Isaak, concerning the distinction between the concept of access control and the product or resource referred to in the art as "secure memory" which Applicants claim in amended claim 1. Applicants respectfully note that Petrovich discloses what is known in the art as access control, while Applicants, on the contrary, claim secure memory, which is clearly distinct from access control. Applicants further respectfully note that, contrary to Examiner's assertion that Applicants argue that "secure" is a term of art (paragraph 44), Applicants assert that "secure memory" is a term of art. Applicants respectfully point out that suppliers of the product called "secure memory" can be found through a search engine such as www.google.com. Applicants have disclosed one way to provide the functionality that the product "secure memory" provides, but there are many such ways.

To further support Applicants' position, Applicants respectfully point out that Petrovich discloses swiping a special bar code or otherwise to set an appropriate frequency for wireless communication and to enter an appropriate code for security and identification purposes. Petrovich also discloses a personal identification number that can be used instead or as a supplement for added security. Applicants, on the contrary claim (amended claim 1) secure memory (a term of art), i.e. a means for making the information itself unusable even if it is accessed.

(3) Examiner states (paragraph 8) that Petrovich fails to disclose the central processor to include application software to maintain a budget, to perform finance computations, and to track financial accounts.

(4) Examiner states (paragraph 9) that Treyz, which Examiner relies upon to meet some of the patentable features of Applicants' claimed invention, teaches a handheld computing device that includes software to maintain a budget ("limit", col. 46, lines 42-61, FIG. 75) and to track financial accounts, when a user uses the device to pay for a purchase (col. 17, lines 60-65). Examiner also states (paragraph 44) that Applicants' arguments regarding the limitation "perform finance computations" appears to be narrower than what is presented in the claims, and that any running total of items is considered to be a finance computation.

As a rebuttal to Examiner's position, Applicants respectfully point out that Treyz discloses (col. 17, lines 60-65) a handheld device that may be used for financial transactions such as to pay for a product in a store through conveying information on the user's credit card, for example, to cash register in a store. Treyz also discloses (col. 46, lines 42-61) a handheld computing device for establishing spending limits for financial transactions. Applicants respectfully point out that neither paying for purchases nor establishing spending limits is equivalent to Applicants' claimed tracking financial accounts. Nowhere do either Petrovich or Treyz disclose tracking financial accounts.

(5) Examiner states (paragraph 9) that it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Petrovich as taught by Treyz, such that the Petrovich implements software to maintain a budget, perform finance computation, and track financial accounts, so that a user can monitor and restrict spending, and make payments without any additional payment devices.

As a rebuttal to Examiner's position, Applicants respectfully point out that, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some

suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Further, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

Applicants respectfully point out that there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references to have the infrastructure to support tracking financial accounts. If one were to graft tracking financial accounts onto either Petrovich or Treyz, neither would be successful because both lack the security necessary to maintain the privacy of, for example, a bank account. Applicants, on the contrary, provide enhanced security measures to protect the financial accounts, in particular, secure memory.

Applicants further respectfully point out that since Petrovich and Treyz, separately or in combination, do not teach or suggest each and every element of Applicants' amended independent claim 1, either expressly or inherently, Applicants' amended independent claim 1 (as well as dependent claims 2-17 and 25 that depend directly or indirectly therefrom and that further define the invention) is not made obvious by Petrovich and Treyz, and a rejection under 35 U.S.C. § 103(a) is inappropriate. Applicants assert that independent amended claim 1 (as well as dependent claims 2-17 and 25 that depend directly or indirectly therefrom) is now in

condition for allowance. Applicants respectfully request the withdrawal of rejections under 35 U.S.C. § 103(a) with regards to dependent claims 2-17 and 25 for the reasons set forth above.

Further remarks with regard to the patentable distinctions of Applicants' claimed invention over Petrovich in view of Treyz are provided below.

With respect to dependent claim 2, on page 5, in paragraphs 10-11,

(1) Examiner states (paragraph 10) that Petrovich discloses a plurality of antennas that enable non-interfering and secure communications between the appliance and the merchant's computer. Examiner states that Petrovich's appliance can receive signals based on the location of the appliance with respect to the antennas and that the merchant computer transmits product information to the appliance (col. 6, line 54 to col. 7, line 7).

As a rebuttal to Examiner's position, Applicants respectfully point out that Petrovich discloses either (a) a position sensing module 90 within the portable terminal 40 that can interface with a GPS or similar system to sense the position of the user within the shopping establishment or (b) receivers located throughout the shopping establishment to sense the presence of the user carrying portable terminal 40. Applicants, on the contrary, claim a plurality of antennas capable of non-interfering and secure communications between the purchasing aid logistics appliance and a merchant's computer. Nowhere does Petrovich disclose non-interfering and secure communications between the portable terminal and the merchant's computer through a plurality of antennas.

(2) Examiner states (paragraph 10) that Petrovich does not explicitly disclose these means for inputting information to be accomplished with a radio receiver.

(3) Examiner states (paragraph 11) that Treyz teaches (col. 15, lines 25-35) a handheld shopping appliance 12 that includes a plurality of antennas capable of enabling non-interfering and secure communications between the appliance and a merchant computer for a plurality of simultaneous signals. Applicants respectfully point out that Treyz discloses a handheld

computing device 12 that includes wireless communications circuitry 96 that may include one or more antennas, transmitters, receivers, etc. and that may support remote wireless communications and local wireless communications. Nowhere does Treyz disclose a plurality of antennas enabling non-interfering and secure communications between the handheld computing device 12 and the merchant's computer.

(4) Examiner states (paragraph 11) that Treyz discusses RF communications (col. 13, lines 16-21 and col. 15, lines 33-35) and discloses (col. 3, lines 31-36) that the means for inputting information is a radio receiver that is capable of receiving signals based on the location of the radio receiver with respect to the plurality of antennas from radio transmitter coupled to the merchant computer through the plurality of antennas. Applicants respectfully point out that Treyz discloses (col. 3, lines 31-36) that location-based shopping services may be provided, and that location-based advertisements may be displayed on the handheld computing device. The plurality of antennas previously referred to (col. 15, lines 25-35) are all a part of Treyz's handheld computing device 12 (FIG. 4), so that "receiving signals based on the location of the radio receiver (on the handheld device) with respect to the plurality of antennas" is not compatible with Examiner's citation.

(5) Examiner states (paragraph 11) that Treyz teaches (col. 28, lines 18-29) that the merchant computer transmits product information in response to a signal by the appliance for product information. Applicants respectfully point out that Treyz discloses that if the user scans or uses RFID to identify a sweater, information about the sweater may be displayed on the screen, and the user may be connected to a website to order the item. Applicants, on the contrary, claim a merchant computer (analogous to the store 276 and server 274 of Treyz) that transmits product information in response to a signal by the purchasing aid logistics appliance for product information. Treyz discloses a merchant's website that allows on-line ordering, but

Treyz does not disclose a merchant computer that is capable of enabling each of a plurality of antennas independently based on the location of the purchasing aid logistics appliance.

(6) Examiner states (paragraph 11) that it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Petrovich as taught by Treyz in order to provide product information at the user's request, and inform the user of special offers, depending on their location. As a rebuttal to Examiner's position, Applicants respectfully refer to the previous iteration of the basic criteria to point establish a *prima facie* case of obviousness. Applicants respectfully point out that there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references to include non-interfering and secure communications between the handheld device and the merchant's computer through a plurality of antennas. Further, the prior art references do no teach or suggest all the claim limitations, in particular, neither reference teaches nor suggests non-interfering and secure communications. Applicants further respectfully point out that it is not obvious how wireless activity would be handled in terms of both interference and security issues, as Applicants have shown (see Specification, paragraphs 55 and 56). Thus, the mere mention of wireless transmissions in Treyz does not create an appropriate teaching to negate the patentability of Applicants' claimed invention. As stated above, Petrovich and Treyz do not substantially teach the limitations of independent claim 1, from which dependent claim 2 depends, and therefore Applicants assert that dependent claim 2 is in condition for allowance.

With respect to dependent claim 3, on page 6, in paragraph 12,

(1) Examiner states that fails to disclose the means for inputting to be an internet port.

(2) Examiner states that Treyz teaches that the computer (28) can communicate with the handheld device (12, column lines 30-32). Applicants respectfully request a full citation for this rejection. Applicants cannot determine to which column Examiner is referring.

With respect to dependent claim 4, on page 6, in paragraph 13, Examiner states that Petrovich discloses (col. 4, line 57) the means for inputting information is a bar code scanner, whereby said bar code scanner scans print media bar codes having product information and generates bar code signals to said central processor for further processing. Applicants respectfully point out that Petrovich discloses a 2-way data interface configured to read bar codes. Applicants respectfully refer to the argument above in claim 1 in which Applicants assert that Petrovich does not disclose a central processor as defined by Applicants.

With respect to dependent claim 8, on pages 6-7, in paragraph 14, Examiner states that Petrovich discloses (col. 7, lines 25-27) inputting information with a keyboard. Examiner states that Treyz discloses (col.15, line 18) that either a keyboard or keypad may be used as an I/O device, thereby establishing these two I/O devices as being equivalent within the art. Applicants respectfully point out that Petrovich discloses a kiosk cradle 24 (see FIG. 6) having a keyboard 1104 for entering a PIN. Applicants, on the contrary, claim a purchasing aid logistics appliance having a keypad to input product information, personal information, and financial information. Neither Petrovich nor Treyz discloses a purchasing aid logistics appliance having a keypad to input product information, personal information, and financial information.

With respect to dependent claims 9, 13, 15, and 16 on pages 7-8, in paragraphs 15 and 17-19 respectively, Applicants respectfully point out that claims 9, 13, 15, and 16 even further define the invention and should be found allowable based upon the allowability of the claim upon which they depend, either directly or indirectly, namely claim 1.

With respect to dependent claim 11, on page 7 of the Office Action, in paragraph 16, Examiner states that Petrovich discloses (56 linked to 16) that the central processor transmits a first signal to said means for outputting, whereby said means for outputting transmits said first signal to a merchant computer. Applicants respectfully point out that Petrovich discloses a point of sale checkout terminal 56 coupled to host computer 16. Petrovich does not disclose a

purchasing aid logistics appliance having a central processor that transmits a first signal to the means for outputting of the purchasing aid logistics appliance, whereby the means for outputting transmits the first signal to a merchant computer.

With respect to independent claim 18, on pages 8-9, in paragraphs 20-21,

(1) Examiner states (paragraph 20) that Petrovich discloses a method for using a purchasing aid logistics appliance 40 comprising downloading product data from a bar coded advertisement. Applicants respectfully point out that Claim 18 does not contain a bar coded advertisement.

(2) Examiner states (paragraph 20) that Petrovich discloses (24 linked to 16) transmitting said shopping list to a merchant computer upon entry into a merchant facility. Applicants respectfully point out that Petrovich discloses a kiosk connected to a host computer, but does not disclose a method including the step of transmitting a shopping list to a merchant computer upon entry into a merchant facility.

(3) Examiner states (paragraph 20) that Petrovich discloses (col. 7, lines 18-27) receiving product data from said merchant computer upon entry into said merchant facility. Applicants respectfully point out that Petrovich discloses a kiosk cradle 24 that includes a portable terminal-receiving station and optical interface. The kiosk cradle may have an attached printer 96 to print out the shopping list and recipes, etc., a display 200, a keyboard 1103, and a smart card reader. Petrovich does not disclose the step of receiving product data from said merchant computer upon entry into said merchant facility.

(4) Examiner states (paragraph 20) that Petrovich discloses (col. 12, lines 49-57) transmitting said shopping cart file to said merchant computer to checkout. Applicants respectfully point out that Petrovich discloses checking out at a point of sale check out terminal

56 in which a computerized list is presented and uploaded to terminal 56. Petrovich does not disclose transmitting a shopping cart file to the merchant computer (equivalent to Petrovich's host 16) to checkout.

(5) Examiner states (paragraph 20) that Petrovich fails to show the product data to be downloaded from a web site.

(6) Examiner states (paragraph 21) that it would have been obvious to modify Petrovich as taught by Treyz such that means for inputting information includes an internet port, so the user may add items to a list while at home without having any other product information available such as a bar code.

As a rebuttal to Examiner's position, Applicants respectfully refers to the argument for claim 1 above in which the criteria to establish a *prima facie* case of obviousness are introduced. There is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references to transmit the shopping list to a merchant computer upon entry into a merchant facility, or to receive product data from the merchant computer upon entry into the merchant facility and the prior art references do not teach or suggest all the claim limitations.

Applicants further respectfully point out that since Petrovich and Treyz, separately or in combination, do not teach or suggest each and every element of Applicants' amended independent claim 18, either expressly or inherently, Applicants' amended independent claim 18 is not made obvious by Petrovich and Treyz, and a rejection under 35 U.S.C. § 103(a) is inappropriate. Applicants assert that independent amended claim 18 is now in condition for allowance. Applicants respectfully request the withdrawal of rejection under 35 U.S.C. § 103(a) with regards to independent claim 18 for the reasons set forth above.

With respect to dependent claims 24, 25, and 5 on pages 9-10, in paragraphs 22-26, Applicants respectfully point out that claims 24, 25, and 5 even further define the invention and should be found allowable based upon the allowability of the claims upon which they depend, either directly or indirectly, namely claims 1 and 22.

On pages 10 and 17, in paragraphs 27, 28, and 50, Examiner states claims 12 and 14 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Petrovich in view of Treyz as applied to claim 1 above, and further in view of WO 01/20526 (WO '526).

Applicants respectfully point out that Examiner's cited reference, WO '526, published on March 22, 2001, was published within one year of the filing date of the present application, January 4, 2002. Applicants respectfully reserve the right to file a petition under 37 C.F.R. § 1.131 to swear behind the WO '526 reference.

With respect to dependent claims 12 and 14,

(1) Examiner states (paragraph 27) that neither Petrovich nor Treyz discloses the first signal to comprise a credit or debit card number and personal identification number.

(2) Examiner states (paragraph 28) that WO '526 teaches a method of electronic payment where either credit card or debit card numbers (page 16, lines 19-20) and a PIN number ("customer identification number") are transmitted to a merchant computer. Examiner considers this to be the first signal transmitted, as WO '526 does not discuss any other signal being transmitted to the merchant computer. Applicants respectfully point out that WO '526 does not disclose Applicants' claimed personal identification number capable of being a basis for unlocking said secure memory. Applicants claim secure memory, which is described to be implemented, for example, such that sequential logical memory address locations are physically encrypted according to the algorithm of FIGs. 9, 10 and 11 in Applicants' specification. As Applicants

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describe, Applicants' claimed personal identification number becomes part of an encoding variable that encrypts the translation of physical address to logical address, and visa versa, thus making it necessary, when secure memory is used, to have a first signal comprising a personal identification number in order to be able to take the step of decrypting memory before proceeding to process other incoming information.

(3) Examiner states (paragraph 28) that it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the combination of Petrovich and Treyz as taught by WO '526, such that either a credit card number or debit card number, along with a PIN number is the first signal transmitted to a merchant computer, as a means of tendering payment.

As a rebuttal to Examiner's position, Applicants respectfully refers to the argument for claim 1 above in which the criteria to establish a *prima facie* case of obviousness are introduced. There is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references wherein the personal identification number is capable of being a basis for unlocking secure memory, and the prior art references do not teach or suggest all the claim limitations.

Applicants further respectfully point out that since Petrovich, Treyz, and WO '526, separately or in combination, do not teach or suggest each and every element of Applicants' dependent claims 12 and 14, either expressly or inherently, Applicants' dependent claims 12 and 14 are not made obvious by Petrovich, Treyz, and WO '526, and a rejection under 35 U.S.C. § 103(a) is inappropriate. Applicants assert that dependent claims 12 and 14 are now in condition for allowance. Applicants respectfully request the withdrawal of rejection under 35 U.S.C. § 103(a) with regards to dependent claims 12 and 14 for the reasons set forth above.

On pages 11 and 18, in paragraphs 29-31 and 50-51, Examiner states that Claims 6 and 7 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Petrovich in view of Treyz as

applied to claim 4 above, and further in view of Shaw, United States Patent Number 6,568,596, issued May 27, 2003 (Shaw).

Applicants respectfully point out that Examiner's cited reference, Shaw, issued on May 27, 2003, was published after the filing date of the present application, January 4, 2002. Applicants respectfully reserve the right to file a petition under 37 C.F.R. § 1.131 to swear behind the WO '526 reference.

With respect to dependent claims 6 and 7,

(1) Examiner states (paragraph 29) that neither Petrovich nor Treyz disclose the central processor to include software that converts the bar code signals into a web page to be displayed on the display.

(2) Examiner states (paragraph 30) that Shaw teaches (col. 3, line 51 to col. 4, line 6) a method where a bar code is converted into a web page and displayed. Examiner states that this method allows information to be published in near real time, as the scanned information is already in a markup language. Examiner disagrees (paragraph 51) with Applicants' argument that Shaw does not disclose the capability of embedding one of a plurality of computer languages in a bar code, decoding the bar code, and displaying a web page on a purchasing aid logistics appliance. Examiner states (paragraph 51) that Shaw explicitly discloses the XML as one language that can be interpreted based on the bar code, and that other languages may be used. Examiner states that Shaw discloses reading a bar code and converting that information into a web page display. Examiner states that Petrovich and Treyz show the purchasing aid logistics appliance that includes a bar code scanner and executes a code.

Applicants respectfully point out that Shaw discloses a data collection definition (DTD) that, when merged with incoming bar codes, produces XML-formatted data. Shaw discloses that

the XML documents are transmitted via a wired or wireless link to an XML element storage system, and are available for immediate publication on the web or for later reuse. The bar codes that Shaw reads must be merged with a specific DTD for XML. Applicants, on the contrary, claim (claim 7) executable software that provides a decoder that provides parsing information, a parser to create display executable code from the parsing information, and a display browser to create a web page from the display executable code directly on the purchasing aid logistics appliance. It is a very different matter to present display executable code on a host computer as Shaw discloses and to present display executable code on a purchasing aid logistics appliance display as Applicants claim. Neither is it obvious from the disclosures of Petrovich, Treyz, and Shaw how to convert a bar code from a plurality of different languages into a displayed web page within the confines of a purchasing aid logistics device.

(3) Examiner states (paragraph 30) that it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Petrovich and Treyz as taught by Shaw such that central processor includes software to convert bar codes into a web page.

As a rebuttal to Examiner's position, Applicants respectfully refers to the argument for claim 1 above in which the criteria to establish a *prima facie* case of obviousness are introduced. There is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references wherein said central processor includes executable software to convert bar code signals into a web page to be displayed on said display (the display of the purchasing aid logistics appliance).

(4) Examiner states (paragraph 31) that Shaw discloses a bar code capable of representing a display in one of a plurality of computer languages, a decoder having at least one decode table, a parser capable of creating display executable code to build the display from the parsing information, a display browser, and a plurality of computer languages.

Applicants respectfully request a citation within Shaw that discloses the above-listed features.

(5) Examiner considers (paragraph 31) any bar code to be capable of representing a display.

Applicants respectfully point out that the patterns of a bar code must be constructed in certain specific ways to produce a desired result, for example, product information, contents identification, or, in the case of the present invention, a display.

(6) Examiner states (paragraph 31) that the decoder, parser, and display browser are inherent in Shaw.

Applicants respectfully point out that the general rule of inherency may be relied upon only where the consequences of following the reference disclosure always inherently produces or results in the claimed invention. *W.L. Gore Associates, Inc. v. Garlock Inc.*, 220 U.S.P.Q. 303, 314. If there is not a reasonable certainty that the claimed subject matter will necessarily result, the rejections fails. *In re Brink*, 164 USPQ 247. Also, accidental results, not intended and not anticipated, do not constitute an anticipation. *Georgia-Pacific Corp. v. United States Plywood Corp.*, 118 USPQ 122, 128. MPEP § 2112 (page 2100-53, May 2004) states that to establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 U.S.P.Q.2d 1746, 1749 (Fed. Cir. 1991). "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

Applicants respectfully point out Shaw does not disclose or suggest a decoder that can determine a selected language from a plurality of computer languages, and can convert bar code signals into the selected language. There is no basis in fact and/or technical reasoning to reasonably support the determination that Applicants' decoder necessarily flows from the teachings of the Shaw. Applicants assert that one skilled in the art would not be able to instantly demonstrate Applicants' decoder from the disclosure of Shaw as to defy dispute.

(7) Examiner states (paragraph 31) that the bar code containing the computer languages can be converted into a web page.

Applicants respectfully request a citation within Shaw to support Examiner's statement.

Applicants respectfully point out that since Petrovich, Treyz, and Shaw, either singly or in combination, do not teach or suggest each and every element of Applicants' dependent claims 6 and 7, either expressly or inherently, Applicants' dependent claims 6 and 7 are not made obvious by Petrovich, Treyz, and Shaw and a rejection under 35 U.S.C. § 103(a) is inappropriate. Applicants respectfully request that Examiner withdraw the rejection under 35 U.S.C. § 103(a) directed to dependent claims 6 and 7 and find dependent claims 6 and 7 in condition for allowance. As stated above, Petrovich and Treyz do not substantially teach the limitations of independent claim 1, from which dependent claims 6 and 7 depend, and therefore Applicants assert that dependent claims 6 and 7 are in condition for allowance.

On pages 12-13, paragraphs 32-33 and 52 of the Office Action, dependent claims 10 and 17 are rejected under 35 U.S.C. §103(a) as being unpatentable over Petrovich in view of Treyz as applied to independent claim 1, and in further view of Kawan, United States Pat. No. 6,012,049, issued on January 4, 2000 (Kawan).

Applicants have amended dependent claim 10 to provide consistency with amended claim 1, which was amended under 37 C.F.R. § 1.116 to put claim 1 in condition for allowance, and Applicants have amended claim 17 to provide consistency with amended claim 10.

Claim 10: (currently amended) The portable 2-way secure purchasing aid logistics appliance according to claim 1 wherein said ~~means for providing~~ secure memory includes ~~a smart card reader and~~ encryption circuitry.

Claim 17: (currently amended) The portable 2-way secure purchasing aid logistics appliance according to claim 10 wherein said central processor further includes executable software to compare smart card information and user personal identification number to data stored in a smart card and said central processor to prevent unauthorized use of said portable 2-way secure purchasing aid logistics appliance, wherein said smart card information is read from a smart card reader integrated with said purchasing aid logistics appliance.

Applicants respectfully request Examiner to reconsider the rejection in light of the arguments presented above with respect to independent claim 1 and further with respect to these amendments. To further Applicants' position of the patentability of amended dependent claims 10 and 17, Applicants respectfully note the following.

With respect to dependent claim 17,

(1) Examiner states (paragraph 32) that Petrovich discloses (col. 7, line 26) a smart card reader.

As a rebuttal to Examiner's position, Applicants respectfully point out that Petrovich discloses a kiosk cradle having a smart card reader. Petrovich does not disclose a portable terminal with a smart card reader. Applicants, on the contrary, claim a purchasing aid logistics appliance in which smart card information and user personal information are used by executable software within a purchasing aid logistics appliance to prevent unauthorized use of the

purchasing aid logistics appliance, and where smart card information is read from a smart card reader integrated with the purchasing aid logistics appliance. Applicants' smart card reader is integrated with the purchasing aid logistics appliance, and not part of a separate kiosk cradle.

(2) Examiner states (paragraph 32) that neither Petrovich nor Treyz disclose encryption circuitry, and a smart card storing a user personal identification number.

(3) Examiner states (paragraph 33) that Kawan teaches (abstract, col. 5, lines 43-55) a system that interfaces with a smart card with a smart card reader. Examiner states that Kawan teaches (col. 5, lines 44-45) that the smart card provides secure account information of a user and includes encryption circuitry. Examiner states that Kawan discloses (col. 5, lines 48-56) a central processor that further includes executable software to compare smart card information and personal identification number to stored data to prevent unauthorized use of the smart card and unauthorized access to a financial account.

As a rebuttal to Examiner's position, Applicants respectfully point out that Kawan discloses a smart card that incorporates digital encryption signatures and encryption algorithms to enable the smart card to be validated from a remote location such as a host computer or merchant terminal. Kawan discloses that both the smart card and the host computer would have encryption keys so that data that is sent via the smart card can be validated by the host computer. Kawan discloses that the host computer is able to validate that the smart card is authentic and the proper user is using the smart card. With respect to claim 10 (and claim 17 that depends from claim 10), Applicants, on the contrary, claim a purchasing aid logistics appliance that having secure memory that includes encryption circuitry, not a smart card that includes encryption circuitry. Nowhere does Kawan disclose a purchasing aid logistics appliance having secure memory that includes encryption circuitry. With respect to claim 17, Applicants, on the contrary, claim a purchasing aid logistics appliance having a central processor that includes executable software to compare smart card information to data stored on a smart card, where the

data are read from a smart card reader that is integrated with the purchasing aid logistics appliance. Nowhere does Kawan disclose a purchasing aid logistics appliance having an integrated smart card reader.

(4) Examiner states (paragraph 33) that it would have been obvious to modify Petrovich and Treyz as taught by Kawan in order to prevent unauthorized access to personal information and account information.

As a rebuttal to Examiner's position, Applicants respectfully refers to the argument for claim 1 above in which the criteria to establish a *prima facie* case of obviousness are introduced. There is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references wherein said secure memory includes encryption circuitry, and wherein the central processor of the purchasing aid logistics appliance includes executable software to compare smart card information to data stored in a smart card that is read from a smart card reader that is integrated with the purchasing aid logistics appliance..

Applicants respectfully point out that since Petrovich, Treyz, and Kawan, either singly or in combination, do not teach or suggest each and every element of Applicants' dependent claims 10 and 17, either expressly or inherently, Applicants' dependent claims 10 and 17 are not made obvious by Petrovich, Treyz, and Kawan, and a rejection under 35 U.S.C. § 103(a) is inappropriate. Applicants respectfully request that Examiner withdraw the rejection under 35 U.S.C. § 103(a) directed to dependent claims 10 and 17 and find dependent claims 10 and 17 in condition for allowance. As stated above, Petrovich, Treyz, and Kawan do not substantially teach the limitations of independent claim 1, from which dependent claims 10 and 17 depend, and therefore Applicants assert that dependent claims 10 and 17 are in condition for allowance.

On pages 13-14, paragraphs 34-36 and 53 of the Office Action, independent claim 19 is rejected under 35 U.S.C. §103(a) as being unpatentable over Petrovich in view of WO '526 and Ruppert et al., United States Patent Number 5,424,524, issued June 13, 1995.

With respect to independent claim 19,

(1) Examiner states (paragraph 34) that Petrovich discloses (col. 5, lines 55-61) a purchasing aid logistics appliance (40) with a secure memory.

As a rebuttal to Examiner's position, Applicants respectfully point out that Petrovich discloses a personal identification number that can be used instead or as a supplement for added security to guard against theft of terminal 40. Petrovich also discloses that terminal 40 can be used in conjunction with a credit or debit card of the user and can have identical identifying indicia, and that an interface with the magnetic strip reader can be provided for entering credit card information into terminal 40 or directly into host 16. Applicants, on the contrary, claim a purchasing aid logistics appliance that includes secure memory, which Applicants have described in detail previously and have submitted a declaration by a person of ordinary skill in the art, James D. Issak, that substantiates the argument that secure memory refers to a particular device.

(2) Examiner states (paragraph 34) that the means for storing is secure.

As a rebuttal to Examiner's position, Applicants respectfully request a citation that anticipates or makes obvious Applicants' claimed means for storing said shopping list and user personal information in said secure memory.

(3) Examiner states (paragraph 34) that Petrovich does not disclose means for electronic payment or means for calculating the total price of the items, as claimed.

(4) Examiner states (paragraph 35) that WO '526 teaches a shopping list organizer comprising a portable device (112) that includes means for making an electronic payment (page 16, lines 8-31). Examiner states (paragraph 53) that Applicants argue that WO '526 does not

describe how PDA information could be verified by the merchant's employee. Examiner states that Applicants do not explicitly claim this step, that the only limitation in the claim is "means for electronic payment", which WO '526 explicitly discloses. Examiner states that Applicants' argument appears to be narrower than the claim.

As a rebuttal to Examiner's position, Applicants respectfully point out that WO '526 purports to include an electronic payment capability, but nowhere enables an electronic payment process with respect to handheld portable devices. Although the process of electronic payment is well understood, the process with respect to a handheld portable device is not obvious. The mere mention of a capability by WO '526 does not enable that capability. Applicants, on the contrary, fully enable an electronic payment capability, as that capability is well understood, and with respect to a handheld device. Further, Applicants assert that an additional step in Claim 19 is not necessary since the process of electronic payment is well understood, but the process with respect to a handheld device is not.

(5) Examiner states (paragraph 35) that it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Petrovich as taught by WO '526, in order to make quicker payments, and allow the user to make payments without carrying any additional payment devices.

As a rebuttal to Examiner's position, Applicants respectfully refers to the argument for claim 1 above in which the criteria to establish a *prima facie* case of obviousness are introduced. There is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references wherein the purchasing aid logistics appliance includes a fully enabled means for electronic payment.

Applicants assert that since Petrovich, Ruppert, and WO '526, separately or in combination, do not teach or suggest each and every element of Applicants' independent claim 19, either expressly or inherently, Applicants' independent claim 19 is not made obvious by

Petrovich, Ruppert, and WO '526, and a rejection under 35 U.S.C. § 103(a) is inappropriate. Applicants assert that independent claim 19 is now in condition for allowance. Applicants respectfully request the withdrawal of rejections under 35 U.S.C. § 103(a) with regards to independent claim 19 for the reasons set forth above.

On pages 14-15, paragraphs 37-39 of the Office Action, independent claims 21 and 28 are rejected under 35 U.S.C. §103(a) as being unpatentable over Treyz in view of Kawan.

With respect to independent claims 21 and 28,

(1) Examiner states (paragraph 37) that Treyz does not explicitly disclose a encrypting memory coupled to the processor, to safeguard personal and financial information.

(2) Examiner states (paragraph 38) that Kawan teaches (abstract, col. 5, lines 43-55) a system that interfaces with a smart card with a smart card reader. Examiner states that Kawan teaches, with respect to claim 21, that the smart card provides secure account information of a user, and includes encryption circuitry. Examiner states (paragraph 39) that, with respect to claim 28, the encryption of Kawan meets the limitation of "modifying memory coupled to said processor".

As a rebuttal to Examiner's position, Applicants respectfully point out that Kawan discloses a smart card that incorporates digital encryption signatures and encryption algorithms to enable the smart card to be validated from a remote location such as a host computer or merchant terminal. Kawan discloses that both the smart card and the host computer would have encryption keys so that data that are sent via the smart card can be validated by the host computer. Kawan discloses that the host computer is able to validate that the smart card is authentic and the proper user is using the smart card. Applicants, on the contrary, claim a purchasing aid logistics appliance a means for modifying or encrypting memory coupled to a central processor, not a smart card that includes encryption circuitry. Nowhere does Kawan

disclose a purchasing aid logistics appliance having a means for modifying or encrypting memory to safeguard personal and financial information, where the means for modifying memory requires an authentication procedure to reverse the modification.

(3) Examiner states (paragraph 38) that it would have been obvious to modify Treyz as taught by Kawan, such that memory of Treyz is encrypted, thereby safeguarding the user's personal and financial information.

As a rebuttal to Examiner's position, Applicants respectfully refers to the argument for claim 1 above in which the criteria to establish a *prima facie* case of obviousness are introduced. There is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references to include a means for modifying or encrypting memory to safeguard personal and financial information, where the means for modifying memory requires an authentication procedure to reverse the modification.

In view of the absence from any cited reference of Applicants' claimed invention as set forth above, Applicants respectfully urge that Petrovich, Treyz, Ruppert, WO '526, Shaw, Kawan, and inherency, separately or in combination, are legally insufficient to render the presently claimed invention obvious under 35 U.S.C. § 103.

Independent claims 1, 19 and 21, 22, and 28 are believed to be in condition for allowance. All dependent claims are believed to depend upon allowable independent claims, and are therefore also in condition for allowance. Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Although no additional fees are anticipated, the Commissioner for Patents is authorized to charge any additional fees or credit overpayment to Deposit Account No. 03-2410, Order No. 12078-129.
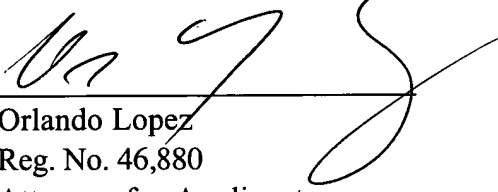
Applicants reiterate that, under 37 C.F.R. § 1.7(a), since March 27, 2005, the date upon which the response is due, falls on a Sunday, the response to this Office Action is being timely filed on Monday, March 28, 2005.

The following information is presented in the event that a call may be deemed desirable by the Examiner: ' ORLANDO LOPEZ (617) 854-4000.

Respectfully submitted,
Joseph Claude Caci et al., Applicants

Date: March 28, 2005   By:

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